

REMARKS

Claims Pending

Claims 1-20 were pending. Claims 1-4 have been cancelled. Thus, claims 5-20 are now pending.

It should be noted that references to canceled claims 1-4 in the remaining claims have been deleted. Where a claim depended solely from claim 1, 2, 3 or 4 the claim has been amended so that it now instead depends from claim 5, which has become the generic claim of broadest scope.

Objections to the Specification

The disclosure has been objected to because, the action asserts, “For the genus of formula (I), the specification lists A as ‘imino’, but all disclosed species have A as ‘amino’.” Appropriate correction has been required.

In the substitute specification, all instances of A being defined as imino have been changed to A being defined as an –NH- group. This is the correction that has been required.

The substitute specification has also been amended in another respect. It will be recalled that the preliminary amendment removed from the specification the phrase “particularly the compounds characterized in claims 5 to 17,” and replaced this with text taken from original claim 5 to 17. Unfortunately, the undersigned has only recently noticed that claims 12 to 17, themselves contain references to original claims 1-4. Thus, introducing into the specification the text of claims 12 to 17 has inadvertently introduced incorporations by reference to claims 1-4. As original claims 1-4 are no longer in the application, incorporations into the specification by reference to these claims are improper. Accordingly, the incorporations by reference to cancelled claims 1-4 have been replaced with text from original but now cancelled claims 1-4.

Claim Rejections Under 35 USC 112

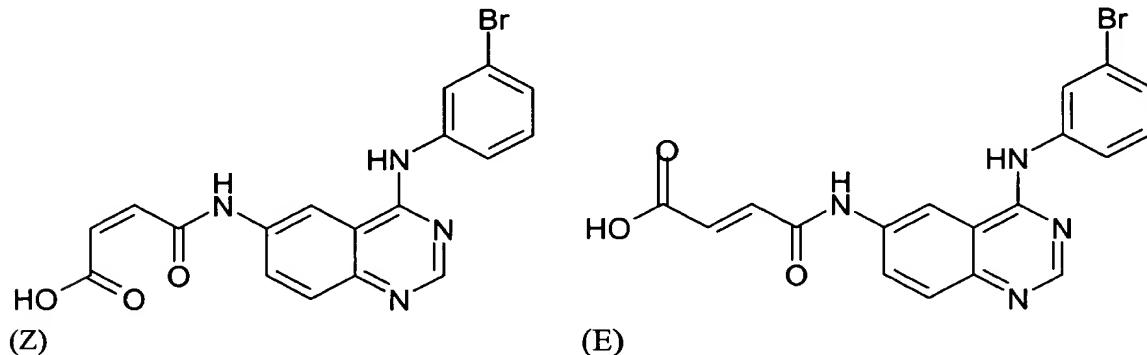
- (a) The rejections of claims 1-4 are rendered moot by the cancellation of these claims.
- (b) Claims 5-16 stand rejected because the definition of A as being "imino" in claims 5-16 is deemed to be incorrect and indefinite, as the disclosed species have an amino group. This basis for rejection is obviated by changing the definition of A (in claims 5-8 and 12-15) so that it is now defined as being an -NH- group. This change does not introduce new matter since, as the Examiner notes, all disclosed species have A as "amino". Thus, those skilled in the art would have understood that the intended definition for A is amino (an -NH- group).
- (c) Claim 17, which is directed to species wherein the group corresponding to A is an "amino" group, is no longer inconsistent with the genus of formula (I) described in the specification, in view of the changes made in the specification.
- (d) The rejection of claims 18-20 as being dependent upon claims 1-17 is obviated by the cancellation of claims 1-4, the amendment of claims 5-16 to obviate rejections thereof, and the correction of the specification which obviates the rejection of claim 17.

Claim Rejections Under 35 USC 102

(a) Rejections under 35 USC 102(b) as anticipated by Wissner et al. (EP 787,722)

(1) The rejection of claim 1 as anticipated by Wissner et al. (EP 787,722) is rendered moot by the cancellation of claim 1.

(2) The rejection of claims 5, 12 and 18-20 as being anticipated by et al. (EP 787,722) is respectfully traversed for the following reasons. The action asserts that the compounds described in EP 787,722, on page 22, at lines 38 and 39 (in claim 4) are embraced by the claims. These compounds have the following structures:

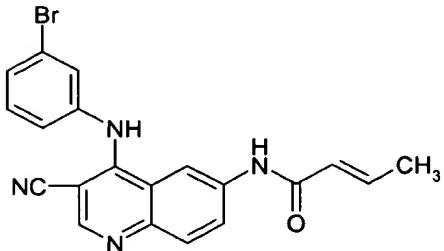


It is respectfully noted that these compounds are not, as asserted in the action, compounds of the claimed formula (I) wherein the moiety D denotes alkylene and E stands for R₆-O-CO- wherein R₆ is hydrogen (a carboxylic acid group). These two compounds do not contain an alkylene group (corresponding to the moiety D) between the 1,2-vinylene group (corresponding to the moiety C) and the terminal carboxylic acid group (corresponding to the moiety E). While claim 1 did embrace compounds wherein D together with E denotes carboxy, claim 1 has been cancelled. The remaining claims, as amended, do not encompass compounds wherein D together with E denotes carboxy. For this reason, it is respectfully urged that the claims as amended do not embrace the two cited compounds of Wissner et al. and that the reference does not constitute an anticipation under 35 USC 102(b).

(b) Rejections under 35 USC 102(a) as anticipated by Wissner et al. (WO 98/43960)

(1) The rejection of claim 1 as anticipated by Wissner et al. (WO 98/43960) is rendered moot by the cancellation of claim 1.

(2) The rejection of claims 5, 12 and 18-20 as being anticipated by Wissner et al. (WO 98/43960) is respectfully traversed for the following reasons. The action asserts that the compound in Example 382 (page 172) of Wissner et al. is embraced by the claims. This compound has the following structure:



It is respectfully noted that this compound is not, as asserted in the action, a compound of the claimed formula (I) wherein the moiety D denotes alkylene and E stands for R_6 -O-CO- wherein R_6 is hydrogen (a carboxylic acid group). While claim 1 did embrace compounds wherein D together with E denotes a C_{1-4} -alkyl group, claim 1 has been cancelled. The remaining claims, as amended, do not encompass compounds wherein D together with E denotes a C_{1-4} -alkyl group. For this reason, it is respectfully urged that the claims as amended do not embrace the two cited compounds of Wissner et al. and that the reference does not constitute an anticipation under 35 USC 102(a).

(c) Rejections under 35 USC 102(a) as anticipated by Wissner et al. (WO 99/09016)

(1) The rejection of claim 1 as anticipated by Wissner et al. (WO 99/09016) is rendered moot by the cancellation of claim 1.

(2) The rejection of claims 5, 12 and 18-20 as being anticipated by et al. (WO 99/09016) is respectfully traversed for the following reasons. The action asserts that the compound in Wissner et al.'s Example 4 (page 47) is embraced by the claims. This compound is the same as that disclosed by EP 787,722 at page 22, line 38. For the same reasons given above with respect to EP 787,722, the cited compound does not fall within the scope of the claims and cannot constitute an anticipation under 35 USC 102(a).

(d) Rejections under 35 USC 102(e) as anticipated by Wissner et al. (US 6,002,008)

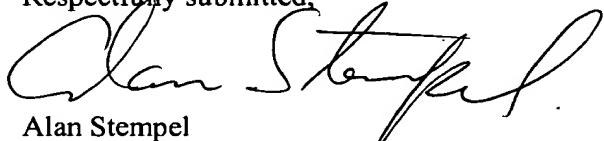
(1) The rejection of claim 1 as anticipated by Wissner et al. (US 6,002,008) is rendered moot by the cancellation of claim 1.

(2) The rejection of claims 5, 12 and 18-20 as being anticipated by et al. (US 6,002,008) is respectfully traversed for the following reasons. The action asserts that the compound x in Wissner et al.'s claim 20 (column 144, line 59) is embraced by the presently rejected claims. This compound is the same as that disclosed by WO 98/43960, in Example 382, at page 172. For the same reasons given above with respect to WO 98/43960, the cited compound does not fall within the scope of the claims and cannot constitute an anticipation under 35 USC 102(e).

Summary

It is respectfully urged that the substitute specification overcomes all objections to the specification and that the amended claims avoid all stated grounds for rejection of the claims and are allowable. Thus, it is further urged that the application as amended is in condition for allowance.

Respectfully submitted,



Alan Stempel
Attorney for Applicant(s)
Reg. No. 28,991

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 798-4868

Enclosures:

- (1) Fee Transmittal (one page)
- (2) Substitute Specification